

The opinion in support of the decision being entered today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FREDDIE GEIER
AND STEFAN BAUER-SCHWAN

Appeal 2007-2128
Application 09/757,006
Technology Center 2100

Decided: August 31, 2007

Before HOWARD B. BLANKENSHIP, JAY P. LUCAS,
and ST. JOHN COURTENAY, III, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 85-91. Claims 1-74 have been canceled. Claims 75-84 have been withdrawn from consideration. We have jurisdiction under 35 U.S.C. §§ 6(b), 134(a).

INTRODUCTION

The claims relate to a graphical user interface for editing and creating Recordable Digital Versatile Discs (DVDR's) on a personal computer or similar device. (Specification 1.) Claim 85 is illustrative:

85. A graphical user interface on a computer-readable medium for assembling and recording media files on a removable storage medium, comprising:

at least one window that defines an area onto which a user can drag and drop one or more files to be recorded on a removable storage medium, said files being displayed within said area as icons;

a control element on said window that enables a user to select from among a plurality of different themes for displayed features of said defined area and said icons; and

a recording control element which, when activated by a user, causes the content of the files in said defined area to be recorded on a removable storage medium.

The Examiner relies on the following prior art references to show unpatentability:

Yang	6,301,586	Oct. 9, 2001
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Screen Dumps of Microsoft Windows NT, Version 4.0, (MS Win)

The rejections as presented by the Examiner are as follows:

1. Claims 85, 86, 88, and 89 are rejected under 35 U.S.C. § 102(b) as being anticipated by MS Win.
2. Claim 87 is rejected under 35 U.S.C § 103(a) as unpatentable over MS Win and Yang.
3. Claims 90 and 91 are rejected under 35 U.S.C § 103(a) as unpatentable over MS Win and Official Notice that storing file data

on a removable storage medium such as a DVD or CD was well known in the art.

OPINION

The Examiner rejects claims 85, 86, 88, and 89 under 35 U.S.C. § 102(b) as being anticipated by MS Win. The statement of rejection refers to “Screen Dumps” as comprising the evidence of unpatentability, and seems to address the evidence as if a “printed publication” under § 102(b). The file copy of the “Screen Dumps” depicts copyright years ranging from 1981 to 1998, which we regard as prima facie evidence that the printed copies provided by the Examiner, which were presumably printed during prosecution of the instant application, were printed or printable (i.e., sufficient to place the invention in public possession) in their present form at least prior to 1999. The “Screen Dumps” could also serve as evidence of public use or sale in this country more than one year prior to the date of application for patent, which are two separate bars to patentability under § 102(b) that are distinct from printed publications.

The printed copy of screen dumps do not qualify as prior art under § 102, but provide evidence of unpatentability under § 102(b). For demonstrating prima facie unpatentability, the rules of evidence are somewhat relaxed in the instant *ex parte* proceedings. For example, hearsay statements in a document that is not “prior art” may be relied upon to establish facts necessary to support a rejection in *ex parte* examination. See *In re Epstein*, 32 F.3d 1559, 1567, 31 USPQ2d 1817, 1822 (Fed. Cir. 1994) (court assumed the truthfulness of various assertions in abstracts that were

not “prior art” publications as to appellant, because the assertions appeared on their face to be accurate and reliable, and because appellant failed to proffer any evidence to support arguments to the contrary).

We will therefore refer to the printed file copy of MS Win as if a printed publication, but remain cognizant that the printed file copy is not a publication but *evidence of* a printed publication as contemplated by 35 U.S.C. § 102(b). In any event, Appellants have not questioned or contested the statutory basis of the rejection. More important, Appellants have not offered any evidence to show that the content of MS Win cannot be properly applied against the instant claims.

With respect to claim 85, the Examiner reads the claimed “at least one window” on window 120, as labeled by the Examiner in “Figure 1” of MS Win. The Examiner finds that highlighted file 110 may be dragged and dropped to window 120 to be recorded on a removable storage medium (drive A; 130). The Examiner reads the claimed “control element” on view/control element 210 (Fig. 2). The Examiner finds that the view/control element enables a user to select from among a plurality of themes such as “Large Icons” 220 and “Small Icons” 230. The Examiner reads the claimed “recording control element” on the right click of a selection device (e.g., a mouse) on an icon, such as file icon 140 (Fig. 1), by which the contents of the file may be recorded on the removable storage medium. (Answer 3-4.)

Appellants submit that the claim 85 “control element” is “on” said window that enables a user to select from among a plurality of different themes. Appellants argue that the menu in Figure 2 of MS Win is not

depicted in conjunction with window 120 in Figure 1, thus not “on” the window. (Br. 3-4.)

The Examiner responds that the view/control element 210 shown in Figure 2 of MS Win operates the same as the view/control element shown in Figure 1 of MS Win, which is on window 120. (Answer 8.) Appellants do not dispute the finding, which we consider to be consistent with the evidence, but add new arguments. (See Reply Br. 1-2.) Appellants submit in the Reply Brief that window 120 contains two “panes.” Appellants allege that the rejection interprets the left “pane” as the “area” recited in claim 85. According to Appellants, the rejection has not established that the “View” menu on window 120 enables the user to select different views within the left “pane.” Rather, in normal operation, the selections offered under the “View” menu pertain to the icons displayed in the *right* “pane.” (Reply Br. 2.)

We do not find any reference to “panes” in the Examiner’s statement of the rejection applied against claim 85. The claim recites at least one window “that defines an area onto which a user can drag and drop one or more files to be recorded on a removable storage medium, said files being displayed within said area as icons.” The claim does not distinguish over all of window 120 in Figure 1 of MS Win being considered an “area” as claimed; moreover, the claimed window “defines” the area. In view of the broad terms of the claim, it does not matter whether views or selections occur in a right or a left “pane” within the window.

We have considered all of Appellants’ arguments in response to the rejection of claim 85, but are not persuaded of error in the finding of

anticipation. We sustain the rejection of claim 85. Claim 86, not separately argued, falls with claim 85. *See* 37 C.F.R. § 41.37(c)(1)(vii).

We also sustain the § 102(b) rejection of claim 88, where the shape of the icons is “determined” by the selected theme, and of claim 89, where said defined area is displayed with a background image that is “determined” by the selected theme. Appellants appear not to appreciate the Examiner’s position (e.g., Answer 9) that the shape of icons or the background image being “determined” by the selected theme does not require that the shape of icons or the background image be selectable as a function of selecting a particular theme. In MS Win, as interpreted by the Examiner, when a theme such as “Large Icons” is selected, that theme determines the shape of the icons and the background image. When a theme such as “Small Icons” is selected, that theme determines the shape of the icons and the background image. So far as the language of the claims is concerned, the shape of the icons may be identical in the two themes; the background image may be identical in the two themes. Appellants’ arguments are not commensurate with the broad scope of the claims.

Claim 87 stands rejected under 35 U.S.C § 103(a) as unpatentable over MS Win and Yang. Appellants acknowledge that Yang discloses that a user can view the contents of an album (comprised of multimedia objects) as a slideshow, and has control over certain options. (Br. 6.) Appellants submit, however, that Yang does not relate to the recording of multimedia objects onto a removable storage medium. Appellants allege there is no teaching in MS Win or Yang that suggests an interface that enables the user

to retrieve and record media files on a removable storage medium, so that they are played back in the manner of a slideshow. (*Id.*)

Claim 87 is drawn to a “graphical user interface.” The interface includes a control element that causes an icon to be displayed in said defined area onto which the user can drag and drop image files. The graphical user interface does not record anything on a removable storage medium. The graphical user interface does not present anything on a media playback device. The use of icons for managing computer files was (and is) widely known; see, e.g., “Recycle Bin” in Figure 2 of MS Win. MS Win and Yang establish that the ordinary artisan was well acquainted with the use of icons to represent what a user may wish to do with files, as represented by the dragging and dropping of icons on a graphical user interface. Although claim 87 does not require any kind of a slideshow, Yang also demonstrates that the artisan knew about storing image files on different types of storage media, as the Examiner finds, and about presenting the files in the format of a slideshow (e.g., Yang Figs. 6 and 26).

To be nonobvious, an improvement must be “more than the predictable use of prior art elements according to their established functions.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007). Even if we presume that claim 87 requires more than activation of a control element that causes display of an icon,¹ the

¹ The name given to the icon relates to nonfunctional descriptive material, entitled to no patentable weight. The content of the nonfunctional descriptive material carries no weight in the analysis of patentability over the prior art. *Cf. In re Ngai*, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004) (“[w]here the printed matter is not functionally related to the

claim reflects no more than the predictable use of prior art elements according to their established functions. We are not persuaded that the subject matter as a whole of instant claim 87 would have been nonobvious to the artisan at the time of invention. We sustain the § 103(a) rejection of claim 87.

We also sustain the § 103(a) rejection of claims 90 and 91 over MS Win and the Examiner's Official Notice. The claims differ from MS Win in reciting that the recording control element causes the files in said defined area to be "burned" (stored) onto a DVD or CD, rather than stored on a (removable) floppy disk or fixed disk. Appellants do not deny that storing file data on a removable storage medium such as a DVD or CD was well known in the art. We find the combination of MS Win and Official Notice sufficient to show suggestion for a graphical user interface as claimed, i.e., the simple substitution or addition of control elements for storing files to other known types of removable storage media.

Appellants allege that in 1998 a separate application was required to record data onto a CD or DVD with the prior art operating system shown by MS Win. (Br. 5.) We might accept that to be true, but Appellants do not allege that on or about the time of invention -- the prima facie date of

substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability," (quoting *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983)); *In re Lowry*, 32 F.3d 1579, 1582, 32 USPQ2d 1031, 1033 (Fed. Cir. 1994) ("Lowry does not claim merely the information content of a memory. . . . [N]or does he seek to patent the content of information resident in a database."). See also *Manual of Patent Examining Procedure* (MPEP) § 2106.01 (8th Ed., Rev. 5, Aug. 2006).

January 8, 2001 -- a separate application was required to record data onto a CD or DVD.

In any event, the inquiry with respect to claims 90 and 91 relates to what the prior art would have suggested that the artisan do (i.e., obviousness), rather than what the artisan did (i.e., anticipation). While a reference must enable someone to practice the invention in order to anticipate under § 102, a non-enabling reference may qualify as prior art for the purpose of determining obviousness under § 103. *Symbol Techs., Inc. v. Opticon, Inc.*, 935 F.2d 1569, 1578, 19 USPQ2d 1241, 1247 (Fed. Cir. 1991).

CONCLUSION

In summary, the rejection of claims 85, 86, 88, and 89 under 35 U.S.C. § 102(b) and the rejection of claims 87, 90, and 91 under 35 U.S.C. § 103(a) are affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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